

REMARKS/ARGUMENTS

Claims 1, 2, 4-9, 11-13, 15-20, and 22-26 are pending in the present application. No claims were canceled or added. Claims 5, 7, 16, 23, and 25 were amended. Claims 5, 7, 16, 23, and 25 were amended to correct statutory problems and not in response to any art rejection. Therefore, the scope of claims 5, 7, 16, 23, and 25 has not changed. No new matter has been added by any amendments made to the claims. Reconsideration of the claims is respectfully requested.

I. Examiner Interview

Applicants thank Examiner Nguyen for all the courtesies extended Applicants' representative during the November 2, 2006 telephone interview. During the interview, Applicants' representative discussed the prior art of record and the manner in which *Gross* fails to disclose the features recited in the presently claimed invention in independent claims 1, 12, and 23. The Examiner agreed that the proposed amendments to claim 23 and 25 would overcome the rejection of claims 23-26 under 35 USC § 101. The Examiner indicated that she would consider Applicants' other arguments and amendments when submitted. The arguments discussed as well as additional reasons that the claims are not anticipated are set forth in the remarks below.

II. 35 U.S.C. § 101

The Examiner has rejected claims 23-26 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed. The Examiner states as follows:

The claims are directed to a signal directly or indirectly by claiming a medium and the Specification (page 20, line 28-page 21, line 8) recites evidence where the computer readable medium is define as a "wave" (such as signal bearing media, transmission-type media, light wave transmissions). In that event, the claims are directed to a form of energy which at present the office feels does not fall into a category of invention.

Office Action dated 08/07/2006 at page 3.

In response, independent claims 23 and 25 have been amended to recite "A computer program product, in a tangible computer readable storage medium, for magnifying a portion of a document in a browser...." The Examiner agreed that this amendment would overcome the rejection of the claims under 35 USC § 101. Claims 24 and 26 are dependent on claims 23 and 25. Therefore, claims 24 and 26 are also directed to statutory subject matter.

III. 35 U.S.C. § 102, Anticipation

The Examiner has rejected claims 1, 2, 4, 12-13, and 23-24 under 35 U.S.C. § 102 as being anticipated by *Gross et al.* (US 6,044,385) referred to hereinafter as *Gross*. This rejection is respectfully traversed.

Independent Claims 1, 12, and 23

Regarding independent claim 1, the Examiner states as follows:

Gross teaches method for magnifying a portion of a document in a browser on a client (e.g., *an entire document displayed within a computer screen at one time on a global scale while providing the user with an enlarged view of a local area of interest, see Abstract & col. 3, lines 53-57*), comprising:

- presenting a first document in a first display in the browser on the client (e.g., *A graphic representation of the entire document is then exhibited within the window; see Abstract/Sample document 123 can constitute a web page, as previously defined herein. Note that the term "web page" can be distinguished from "pages" contained within a scrollable document such as sample document 123. Thus, sample document 123 can potentially include many individual "pages" within a single "web page"/col.9, lines 20-38 & see Figs. 6 and 9*);
- generating a magnified display of the first document in memory at the client (e.g. *Only a portion of sample document 123 is actually displayed within window 104; col. 8, lines 47-49 & see Fig. 7*);
- displaying in a second display in the browser a selected portion of the magnified display corresponding to a selected portion of the first document (e.g., *After the user "clicks" this particular portion of the entire sample document 123...text or graphics corresponding to the portion of entire sample document chosen from lens bar are displayed within window; col.10, lines 13-30 & see Fig. 8*);
- mapping the selected portion of the magnified display to a display space of the selected portion of the first document (e.g., *The different font format of string text 124 is an indication that the text is hyper-linked to "jump" to another document. When a user clicks on string text 124 with a mouse or other pointing device, the graphical user interface shifts the presently viewed sample document 123 to another hyper-linked document. Those skilled in the art will appreciate that sample document 123 can be displayed within a web browser and can include "links" to other sites within a computer network such as the Internet; col. 9, lines 20-38/ col. 10, lines 56-67 & see Figs. 6and 7*);
- response to receiving a request for an action within the second display; and performing the action with respect to the first document (e.g., *a test is performed to determine whether or not the entire document can be displayed within the graphical user interface window in which the web browser operates. If it is determined that the entire document is displayed within the graphical user interface window, then a lens bar is not necessary for this particular document and the user can utilize a normal scroll bar. Thus, the graphical user interface and web browser application continues to operate normally...if it is determined that the entire document is too large to be displayed within the graphical user interface window, then the graphical user interface application provides a lens bar...the entire document is displayed within the lens bar in its entirety. As illustrated at block 168, a portion of the document is displayed within the lens portion of the lens bar according to a "normal" view; col. 11, lines 1-57 & see Fig. 9*).

Office Action dated August 7, 2006 at pages 4-6.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, each and every feature of independent claims 1 is not identically shown in the cited reference, arranged as they are in the claim 1.

Independent claim 1 recites as follows:

1. A method for magnifying a portion of a document in a browser on a client, comprising:
 - presenting a first document in a first display in the browser on the client;
 - generating a magnified display of the first document in memory at the client;
 - displaying in a second display in the browser a selected portion of the magnified display corresponding to a selected portion of the first document;
 - mapping the selected portion of the magnified display to a display space of the selected portion of the first document; and
 - responsive to receiving a request for an action within the second display, performing the action with respect to the first document.

Independent claims 12 and 23 recite similar subject matter. *Gross* does not teach magnifying a portion of a document in a browser on the client. *Gross* also fails to disclose the generating, displaying, and mapping steps recited in independent claim 1.

Magnifying a portion of a document

Gross does not teach “magnifying a portion of a document in a browser on a client,” as recited in claim 1. The Examiner cites to *Gross* at column 3, lines 53-57 and the Abstract as disclosing magnifying a portion of a document. *Gross* teaches as follows:

A method and system for efficiently managing the manipulation of documents too large to be legibly displayed within a computer screen. Initially, a window is provided within which only a portion of an entire document may be displayed legibly. A graphic representation of the entire document is then exhibited within the window. A portion of the graphic representation of the entire document is displayed as a human discernable representation. A remaining portion of the graphic representation of the entire document is displayed as a compressed representation of a portion of the document. The compressed representation is iconic in nature such that a representation nearest the bottom and the top of the document, and furthest away from the human discernable portion, appears as increasingly iconic characters or graphics. The graphic representation itself is composed of a lens bar that allows a user to interpret an entire document displayed within a computer screen at one time on a global scale, while providing the user with an enlarged view of a local area of interest.

Gross, Abstract.

Here, *Gross* discloses displaying documents that are too large to be legibly displayed on a computer screen. In order to display the entire document on the screen, only a portion of the document is displayed legibly in a normal view. The rest of the document is displayed as a **compressed representation** or decreasing size. Although *Gross* describes the legible portion of the display as an “enlarged view,” *Gross* does not teach magnifying any part of the document. To the contrary, *Gross* teaches **compressing** the document so that more of the document can be displayed on the computer screen. Thus, rather than disclosing magnifying a portion of a document as is recited in claim 1, *Gross* teaches compressing or decreasing the size of a document.

Gross states as follows:

Lens bar 130 thus offers the user a global sense of where the user is located within a long document that does not normally fit entirely within a window such as window 105. A rendering of the entire sample document 132, however, is depicted within window 105. Only a certain number of local lines or number of pixels in the case of a bit-mapped image are displayed “full size” or via a normal view as depicted at lens portion 134. Everything after this localized view is displayed within lens bar 130 in ever decreasing size and height, either continuously or at discrete intervals. Thus, information furthest from the localized view appear the smallest to a user.

Gross, column 10, lines 1-12.

As described above, *Gross* displays a long document that does not fit within a window by displaying only a portion of the document at the full size or normal view. The rest of the document is displayed in **ever decreasing size** and height so that information farthest from the lens portion will appear **smallest** to the user rather than magnifying the first document.

The Examiner also cites to the portion of *Gross* which states:

The graphic representation itself is composed of a lens bar that allows a user to interpret an entire document displayed within a computer screen at one time on a global scale, while providing the user with an enlarged view of a local area of interest.

Gross, column 3, lines 53-57.

As shown in this section of *Gross*, a lens bar allows a user to view an entire document displayed within a computer screen at one time on a global scale by decreasing the size of the document. *Gross* provides a normal view of a selected portion of the document that is legible to the user. Although *Gross* describes the normal view as an enlarged view of a local area of interest, the lens portion is described as enlarged in relation to the compressed or reduced size of the rest of the document. *Gross* describes compressing the rest of the document. When taken in context, the “enlarged portion” of the document described in *Gross* is the normal document view rather than a magnified portion of the document. The normal view of the document is only enlarged as compared to the portion of the display that is

compressed or of ever decreasing size. Thus, *Gross* fails to teach “magnifying a portion of a document in a browser on a client. Quite the contrary, *Gross* teaches compressing or decreasing the size of a portion of a document.

Generating a magnified display of the first document

Gross fails to teach “generating a magnified display of the first document in memory at the client,” as is recited in amended independent claim 1. The Examiner believes this feature is disclosed by *Gross* at column 8, lines 47-49 and Figure 7. The cited portion of *Gross* is included in the following section:

Note that the term "web page" can be distinguished from "pages" contained within a scrollable document such as sample document 123. Thus, sample document 123 can potentially include many individual "pages" within a single "web page." Only a portion of sample document 123 is actually displayed within window 104. Large portions remain unviewable because they are positioned "above" and "below" window 104. Window 104 essentially displays a portion of a viewable object (i.e., sample document 123) constructed from a mark-up language. One such mark-up language that can be utilized in accordance with the example presented in FIG. 6, is the Hypertext Mark-up Language (HTML). The size and position of elevator 120 within scroll bar 116 corresponds to the size and position of the current viewable page in relation to sample document 123. Sample document 123 can be accessed from a computer system contained within a computer network such as the Internet.

In the example of FIG. 6, because sample document 123 includes too many pages to view simultaneously, the user can position a mouse cursor over up-arrow section 106 or down-arrow section 108 of scroll bar 116 and click a pointing device (e.g., a mouse) to scroll the sample document 123 upward or downward, as appropriate. Scroll bar 116 thus provides a scrolling function. "Scrolling," well known in the art of graphical user interface icons, is the process of moving a document in a window such as window 104 to permit viewing of any desired portion. "Scrolling" is so named because it is the electronic equivalent of reading through a rolled or scrolled document rather than flipping through the pages of a book.

Gross, column 8, lines 43-60.

Here, *Gross* describes a scrollable document displayed in a window. The document is too large or too long to display the entire document in the window. So only a portion of the document is displayed or viewable within the window. *Gross* describes a scrollable document in which only a portion of the document is displayed in the window. A user can use the scroll bar to scroll through the document upward or downward to view the other portions of the document. This section of *Gross* only describes a scrollable document and has nothing to do with magnifying a portion of a document or generating a magnified display of a first document in memory at the client.

The Examiner also cites to Figure 7 which illustrates as follows:

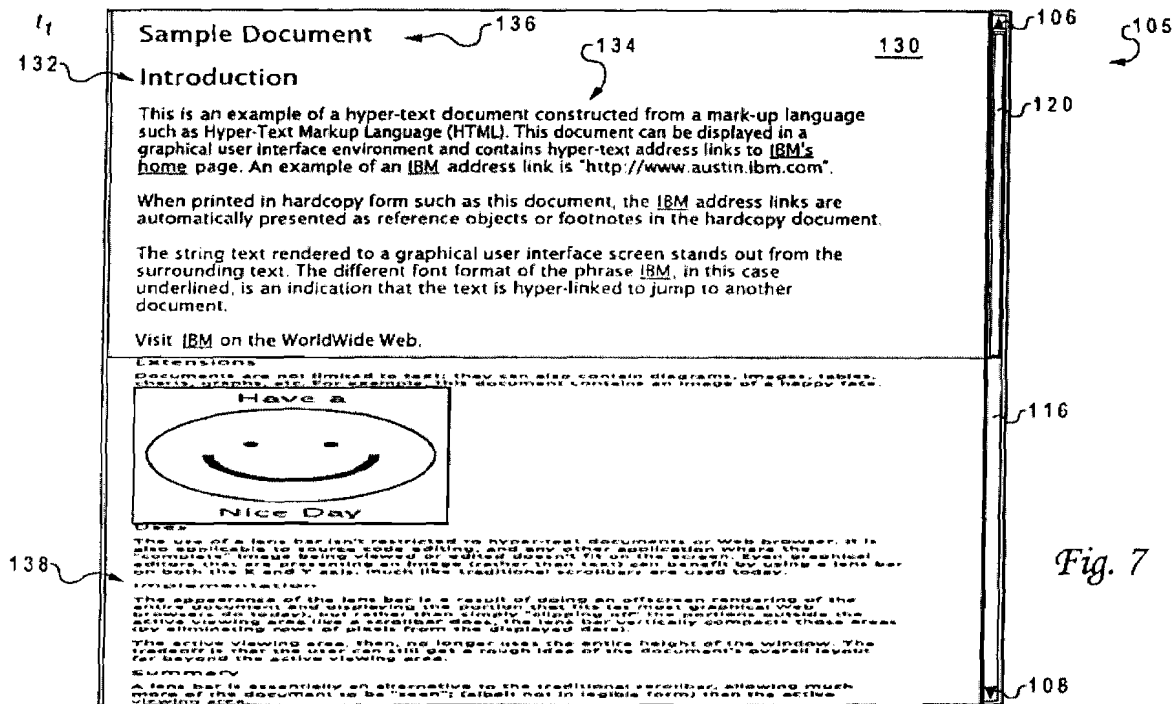


Fig. 7

Gross, Figure 7.

This figure shows a window with an entire document in the display. A normal view of a portion of the document is shown in a part of the window referred to as a lens portion. A user can read the text or graphics in the lens portion. The rest of the document is displayed in ever decreasing size and height so that the entire document can fit in the window. The portion of *Gross* describing Figure 7 states:

FIG. 7 depicts a lens bar 130 displayed within graphical user interface window 105 at an initial time in accordance with a preferred embodiment of the present invention. FIG. 7 illustrates lens bar 130 at time $t_{sub}1$. A sample document 132 is displayed within window 105, which is analogous to window 104 of FIG. 6. Lens bar 130 overlays the entire body of sample document 132. The entire sample document 132 is actually displayed within window 105. A user can utilize scroll bar 116 to scroll lens portion 134 of lens bar 130 through sample document 132. A "normal" view of sample document 132 is indicated at lens portion 134. A user can clearly read text or graphics displayed within lens portion 134. Lens bar 130 also includes a top portion 136 and a bottom portion 138. The top portion 136 displays a beginning portion of sample document 132 and bottom portion 138 displays an ending portion of sample document 132.

Lens bar 130 thus offers the user a global sense of where the user is located within a long document that does not normally fit entirely within a window such as window 105. A rendering of the entire sample document 132, however, is depicted within window 105. Only a certain number of local lines or number of pixels in the case of a bit-

mapped image are displayed "full size" or via a normal view as depicted at lens portion 134. Everything after this localized view is displayed within lens bar 130 in ever decreasing size and height, either continuously or at discrete intervals. Thus, information furthest from the localized view appear the smallest to a user.

Gross, column 9, line 52-column 10, line 12.

As shown above, the document displayed in Figure 7 is a long document that does not normally fit entirely within a window. Only a portion of the document is shown in a normal view. Everything after this view is displayed in ever decreasing size so that the entire document can fit in the window display. Thus, *Gross* teaches decreasing the size of a portion of a document so that a large document can fit in a window rather than generating a magnified display of the first document. Decreasing the size of a portion of the document and displaying another portion of the document at normal size does not teach generating a magnified display of a first document. Moreover, even if, *arguendo*, decreasing a portion of a document could disclose generating a magnified display, *Gross* teaches decreasing the size of only a portion of the document. *Gross* does not teach generating the compressed view of an entire first document in memory at the client. In addition, *Gross* does not state that the lens portion is a magnified display. To the contrary, *Gross* states that the lens portion is a normal view. And even assuming for the sake of argument that the lens portion is a magnified portion of the document, *Gross* does not provide any teachings regarding generating this magnified display. It is not inherent that a magnified portion of a document is displayed by generating a magnified display of the first document in memory at the client. Thus, *Gross* does not disclose "generating a magnified display of the first document in memory at the client," as is claimed in claim 1.

Displaying a selected portion of the magnified display

Gross fails to teach "displaying in a second display in the browser a selected portion of the magnified display corresponding to a selected portion of the first document," as is recited in amended independent claim 1. The Examiner alleges this feature is disclosed by *Gross* at column 10, lines 13-30 and Figure 8. Figure 8 illustrates as follows:

This section of *Gross* explains that the lens portion displays a portion of the document selected by a user in the normal view. As discussed above, the rest of the document is compressed and not legible to the user. Although *Gross* states that lens bar is at a “less” magnified view, when this statement is taken in context, *Gross* is describing the fact that the rest of the document not displayed in the lens portion at the normal size is displayed at the compressed or decreasing size. Moreover, the lens portion does not display a magnified view of a first document, but only displays a selected portion of the document at a normal size as opposed to the compressed or decreasing size. *Gross* does not teach displaying a selected portion of a magnified display of the first document which is generated in memory at the client, in this or any other section of the document. Moreover, displaying a portion of a document in the normal or full size and reducing the size of the remainder of the document is not equivalent to displaying a **magnified** portion of the magnified display because, as discussed above, the lens portion is not a magnified portion of the document.

In addition, even assuming, *arguendo*, that the teachings regarding clicking on a portion of the document to display the selected portion of the lens bar in the lens portion could teach displaying a magnified portion of the document selected by the user in a second display, *Gross* does not teach generating a magnified display of the first document in memory at the client. Therefore, *Gross* cannot teach a selected portion of the magnified display corresponding to the first document. Thus, *Gross* fails to teach “displaying in a second display in the browser a selected portion of the magnified display corresponding to a selected portion of the first document,” as is claimed in claim 1.

Mapping the selected portion of the magnified display

Gross fails to teach “mapping the selected portion of the magnified display to a display space of the selected portion of the first document,” as is recited in amended independent claim 1. The Examiner alleges this feature is disclosed at column 9, lines 20-38, column 10, lines 56-67 and Figures 6 and 7. The cited portion of *Gross* at column 9 states:

Sample document 123 contains specific string text 124 rendered on the screen by the graphical user interface to stand out from the surrounding text. String text 124 is rendered in a different format. In the example of FIG. 6, string text 124 is rendered as IBM. The different font format of string text 124 is an indication that the text is hyper-linked to “jump” to another document. When a user clicks on string text 124 with a mouse or other pointing device, the graphical user interface shifts the presently viewed sample document 123 to another hyper-linked document. Those skilled in the art will appreciate that sample document 123 can be displayed within a web browser and can include “links” to other sites within a computer network such as the Internet. However, those skilled in the art can also appreciate that a stand alone document can be displayed within window 104. In other words, window 104 can comprise a graphical user interface window utilized in conjunction with data-processing applications such as word processors or spread sheets.

Gross, column 9, lines 20-38.

Here, *Gross* discloses links to another document. A user can click on the link to view another hyper-linked document. However, linking to another document does not disclose mapping the selected portion of the magnified display to the first document. Linking to a different document does not map a **selected portion** of the magnified display to a display space of the **selected portion** of the first document. Rather, the hyper-link is a link from one document to a different document. *Gross* does not teach linking a **portion** of a document to a portion of another document. Finally, a link is not equivalent to mapping. A link to a different document does not teach mapping a selected portion of a first document to a selected portion of a magnified display of the first document in memory at the client. Rather, a link is generally understood to teach a hyper-link, such as a URL, for retrieving a web page from a server.

The Examiner also cites to the following section of *Gross*:

As described at block 158, a new document is loaded into the working directory of the data-processing system. For example, in the case of a web browser, the web browser can display a "web page" following activation of a hypertext link to that particular web page. The web page can also include additional hypertext links. Those skilled in the art can appreciate, however, that the method described herein need not necessarily be utilized only in association with a web browser. For example, in the case of a word processing application, a document can be loaded into the working directory of the data-processing system and then utilized by the word processing application in association with the method described herein.

Gross, column 10, lines 56-67.

Again, *Gross* describes a link to a web page. Such disclosure does not teach mapping the selected **portion** of the magnified display of the first document in a second display to a display space of the **selected portion** of the first document. Furthermore, the disclosure of a link here does not provide any teaching regarding mapping a portion of a magnified display generated in memory **at the client** with a portion of the first document in a first display in the browser **on the client**.

The Examiner also cites to Figure 6 and 7. Figure 7 is shown above. As discussed above, Figure 7 illustrates a lens portion with a normal view and a remainder of the document shown at an ever decreasing size. Figure 7 does not illustrate a magnified display or mapping a portion of a magnified display to a portion of the first document. Figure 6 illustrates:

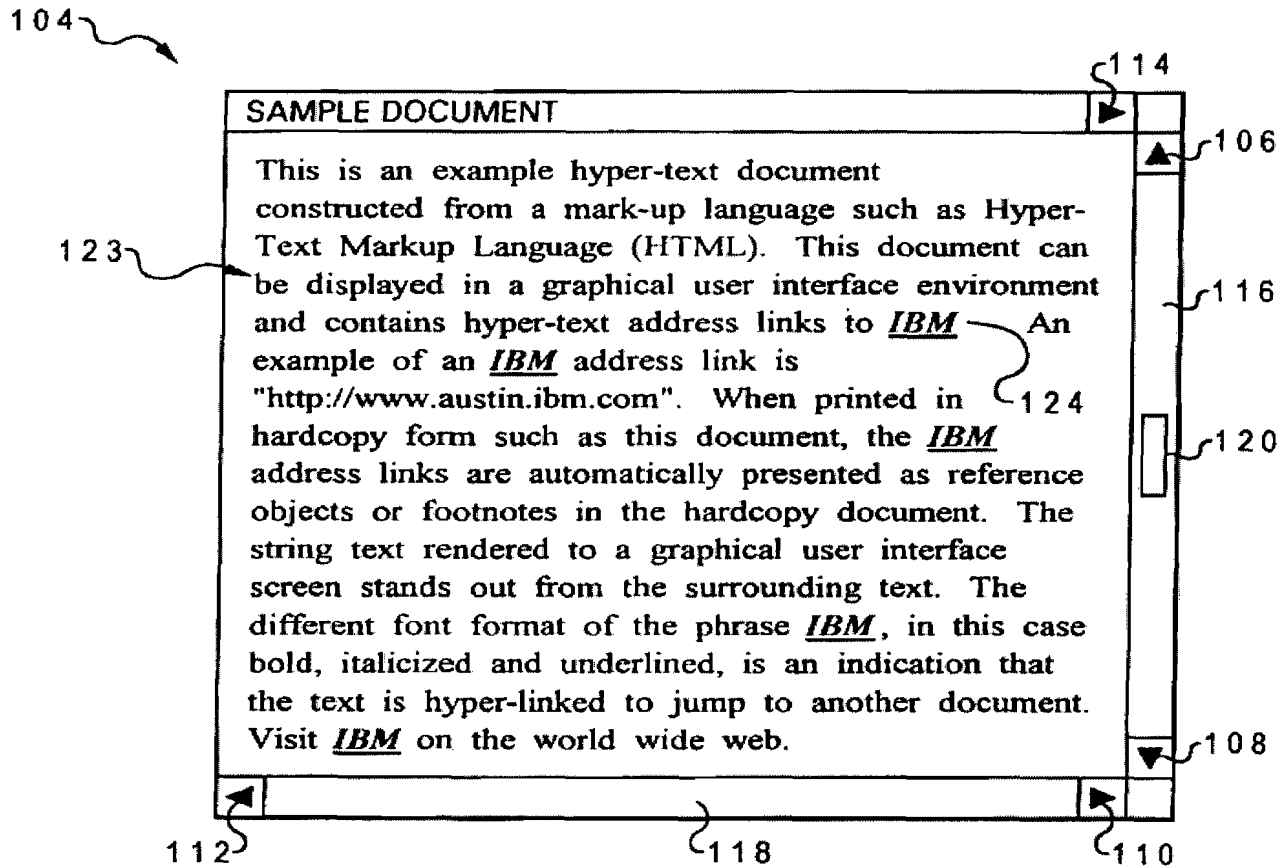


Fig. 6

Gross, Figure 6.

Here, *Gross* depicts a document having a hyper-text link. A link is generally a URL address. However, as discussed above, a link to another document or web page does not disclose mapping a portion of a magnified display to a portion of a first document in the browser on the client. Thus, *Gross* does not disclose “mapping the selected portion of the magnified display to a display space of the selected portion of the first document,” as is claimed in claim 1.

Thus, *Gross* fails to teach each and every feature of independent claim 1. Independent claims 12 and 23 recite similar subject matter. Therefore, independent claims 12 and 23 are distinguishable over *Gross* for the same reasons set forth above with regard to claim 1.

Dependent Claims 2, 4, 13, 15, and 24

Since claims 2, 4, 13, and 24 depend from claims 1, 12, and 23, claims 2, 4, 13, and 24 are distinguishable over *Gross* for at least the reasons set forth above with regard to claims 1, 12, and 23. Additionally, claims 2, 4, 13, and 24 claim other additional combinations of features not suggested by the reference. For example, regarding claims 4 and 15, the Examiner believes that *Gross* discloses mapping

the magnified display to a display space comprising mapping the magnified portion to the first document to form an imagemap at column 9, lines 20-38, column 10, lines 56-67, and Figures 6 and 7. These cited portions of *Gross* and the figures are shown above. These cited portions of *Gross* fail to teach mapping the magnified portion of the first document for the same reasons set forth above with regard to claim 1. In addition, *Gross* fails to disclose an image map in this or any other section of the reference. Consequently, it is respectfully urged that the rejection of claims 2, 4, 12, and 24 have been overcome.

Therefore, the rejection of claims 1, 2, 4, 12, 13, 23, and 24 under 35 U.S.C. § 102 has been overcome.

Furthermore, *Gross* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. *Gross* actually teaches away from the presently claimed invention because it teaches a compressing or reducing the size of a document as opposed to magnifying a portion of a document as in the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement *Gross* and magnifying a portion of a document, one of ordinary skill in the art would not be led to modify *Gross* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Gross* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

IV. 35 U.S.C. § 103, Obviousness

The Examiner has rejected claims 5-7 and 16-18 under 35 U.S.C. § 103 as being unpatentable over *Gross* in view of *Guedalia* (US 6,121,970). This rejection is respectfully traversed.

As discussed above, *Gross* does not teach the features of independent claims 1, 12, and 23. In addition, *Guedalia* fails to make up for the deficiencies of *Gross*. *Guedalia* is directed towards archiving digital data on a server computer and enabling a user to view digital images from the digital data. *Guedalia* provides a view window partitioned into a plurality of sub-regions. A user can select a sub-region. In response, the server sends a new or modified HTML page to the client corresponding to the selected location. However, *Guedalia* does not teach or suggest magnifying a portion of a document in a browser on a client. Therefore, *Guedalia* does not make up for the deficiencies of *Gross*.

One of ordinary skill in the art would not have been motivated to combine the references. The mere fact that the references can be combined and modified does not make the combination and modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) and also see *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) and *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). The Examiner may not merely state that the modification would have been obvious to one of ordinary

skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification. *Gross* does not provide any teaching, suggestion, or motivation to combine *Gross* with *Guedalia*.

Gross does not teach the problem or its source. *Gross* is directed towards solving the problem of displaying a long document on a single display screen. *Gross* teaches:

A problem associated with this type of "scrolling" either in Internet based systems or independent computer systems which utilize graphical user interface devices, is that documents are often too long to fit within a graphical user interface window, well known in the art of data-processing systems. Scroll bars give some sense of the global length of a document displayed within a graphical user interface window, such as a web page, and allow a user to navigate fairly easily through such documents. However, scroll bars lack the ability to allow the user to comprehend how much information is actually located prior to or after a currently displayed portion of the web page or document. Such scroll bars also do not give the user a sense of how this information is "laid out" within the entire document.

Gross, column 3, lines 5-18.

Gross addresses the problem of displaying a long document in a window that a user can get a sense of how the information in the document is laid out. *Gross* does not teach or suggest any problem for which magnifying a portion of a document in a browser would be a solution. In addition, *Guedalia* is directed to the problem of interactive viewing of images on the Internet. *Guedalia* teaches:

The drawback with this client-less approach to image navigation is that it is very processing-heavy on the server side. For every interactive user command, the server has to render a customized image to embed in the dynamic HTML page. Given the rapid pace with which interactive user commands are issued, this puts a heavy burden on the server, greatly slowing down its performance. Moreover the combined latency of the server processing and the network communication makes the user experience a "bumpy" rather than a "smooth" interactive experience; i.e. the navigation experience appears more like a slide show than a continuous animation.

Guedalia, column 3, lines 45-57.

Thus, *Guedalia* is directed to interactive image navigation in a client-less approach. *Gross* and *Guedalia* are directed to different problems, displaying large documents in a single window and image navigation in a client-less approach. The references provide no motivation to one of ordinary skill in the art to combine *Gross* and *Guedalia*.

The Examiner suggests that it would have been obvious to combine *Guedalia* and *Gross* because it would have provided the capability for significantly less re-use of the same image portion. However, less re-use of the same image portion is not a motivation for combining and modifying *Guedalia* and *Gross* to magnify a portion of a document in a browser on a client. The Examiner has not provided any

explanation as to how less re-use of the same image would motivate magnification of a portion of a document.

In addition, even if the references could be combined, the combination of the references would not form the presently claimed invention in claims 5-7 and 16-18. *Gross* teaches compressing or decreasing the size of portions of a document in a window. See *Gross* Abstract. *Guedalia* teaches a window being partitioned into a plurality of imaginary sub-regions. See *Guedalia* Abstract. However, neither reference teaches or suggests generating a magnified display of a first document and displaying a selected portion of the magnified display in a second display in the browser. Thus, a combination of the cited references would result in providing a plurality of sub-regions in the compressed display space.

Finally, the references are not properly combinable or modifiable if their intended function is destroyed. A *prima facie* case of obviousness cannot be properly based upon prior art reference if the prior art reference requires some modification in order to meet the claimed invention and such modification destroys the intended purpose or function of the disclosed invention. As discussed above, *Gross* is directed towards solving the problem of displaying a long document in a single window. *Gross* solves this problem by compressing or decreasing the size of a portion of the document. If *Gross* is modified to magnify a portion of the document as is claimed in claim 1, the function of *Gross* would be destroyed because magnifying a portion of the document would make it more difficult to display the entire document in a window rather than enabling the entire document to be displayed in the window. Therefore, the presently claimed invention can only be reached through an improper use of the disclosed invention as a template to modify the prior art to reach the claimed invention. Therefore, the rejection of dependent claims 5-7 and 16-18 under 35 U.S.C. § 103 has been overcome.

V. 35 U.S.C. § 103, Obviousness

The Examiner has rejected claims 8-9, 11, 19-20, 22, and 25-26 under 35 U.S.C. § 103 as being unpatentable over *Gross* in view of *Szepesvary* (US 6,121,970). This rejection is respectfully traversed.

Independent amended claim 8 claims as follows:

8. A method for magnifying a portion of a document in a browser, comprising:
 - presenting a first document in a first display in the browser;
 - receiving a selection of a portion of the first document;
 - generating a magnified display of the selected portion from the structure of the first document;
 - analyzing a document object model for the first document;
 - identifying a portion of the document object model that corresponds to the selected portion of the first document, wherein the magnified display of the selected portion of the first document is generated at a client based on the corresponding portion of the document object model for the first document;

presenting the magnified display;
receiving a request for an action within the magnified display; and
performing the action with respect to the magnified display.

Claims 19 and 25 recite similar subject matter. Independent claims 8, 19, and 25 recite subject matter addressed above with regard to independent claims 1, 12, and 23. Thus, the same distinctions between the cited prior art references and claim 1 discussed above are applicable to independent claims 8, 19, and 25 with regard to the similarly recited subject matter.

As discussed above, *Gross* fails to teach generating a magnified display of a portion of a first document. In addition, the Examiner acknowledges that *Gross* does not teach analyzing a document object model for the first document. However, the Examiner believes *Szepesvary* teaches this feature at paragraphs 0034-0036. *Szepesvary* teaches as follows:

[0034] To this end, illustrated scanner module 22 traverses the DOM and creates one or more tokens for each element encountered. The process involves grouping sequences of attributes from the HTML DOM into units (tokens) to create a mapping between the DOM elements and the tokens. The generated tokens, which represent the DOM elements, are then passed to the parser 24.

[0035] The tokenized input is interpreted by the parser 24 according to an application specific grammar, to identify and distinguish among the various portions of the application's display. For example, recognizing interactive objects as distinct from textual titles, metatags, unprintable HTML, in-line pictures, etc. The parser can achieve this by grouping the tokens into syntactic structures that identify items displayed in the HTML application. The parser 24 then outputs user interface objects 26 that correspond to graphical elements and other items displayed by the browser.

[0036] FIG. 2 is a flow chart 28 that depicts various steps for implementing this exemplary embodiment of the method of the invention. In step 30, the DOM of a specific application is analyzed and an application-specific grammar is defined. It is important to note that the defined grammar is not a generic grammar for all HTML DOM applications, rather, the defined grammar is specific to a particular application only.

Szepesvary, paragraphs 0034-0036.

Here, *Szepesvary* discloses mapping between DOM elements and tokens that represent the DOM elements. However, *Szepesvary* does not disclose analyzing a document object model for a first document; identifying a portion of the document object model that corresponds to the selected portion of the first document, wherein the magnified display of the selected portion is generated at a client based on the corresponding portion of the document object model for the first document. Moreover, even assuming *arguendo*, that *Szepesvary* does disclose analyzing a document object model for the first document, *Szepesvary* does not teach or suggest magnifying a portion of a document in a browser. Therefore, *Szepesvary* fails to make up for the deficiencies of *Gross*.

A proper *prima facie* case of obviousness must be supported by some teaching or suggestion contained in the combined references. Applicants respectfully submit that the cited references cannot be combined to produce the claimed invention. *Gross* and *Szepesvary*, either alone or in combination, do not give any teaching, suggestion, or incentive to generate a magnified display of the selected portion of the first document from the structure of the first document; identify a portion of the document object model that corresponds to the selected portion of the first document, wherein the magnified display of the selected portion of the first document is generated at a client based on the corresponding portion of the document object model for the first document; presenting the magnified display; and perform an action with respect to the first document in response to receiving a request for an action within the second display. The Examiner alleges it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the feature from *Szepesvary* in the system of *Gross* because it would have provided the capability for recognizing user interface object in HTML applications, as well as for creating computer programs that accept HTML Document Object Model structures as input. However, the Examiner has not explained how this would be a proper motivation to combine and modify *Gross* and *Szepesvary* to generate a magnified display of a portion of a document as is claimed in claim 8.

Moreover, even if it was proper to combine the cited references, the combination of the references would not form the presently claimed invention. As discussed above, *Gross* teaches compressing or decreasing the size of portions of a document. *Szepesvary* teaches recognizing graphical user interface objects in HTML applications. *Szepesvary* teaches:

The present invention provides methods and system for building a computer program, such as a dynamically linked library, capable of recognizing graphical user interface objects in HTML applications. The program accepts HTML DOM structures as input and processes the DOM by 1) creating one or more tokens for each parsed DOM element, and 2) parsing the generated tokens according to an application specific grammar. The program outputs user-interface objects that correspond to the graphical elements and other items displayed in the web browser.

Szepesvary, Abstract.

Szepesvary does not teach magnifying a document or any portion of a document. Therefore, a combination of *Gross* and *Szepesvary* would result in compressing a document and outputting user-interface objects corresponding to the graphical elements and other items displayed in the compressed web page. The combination of the references would not result in magnifying a portion of a document in a browser as is claimed in claim 8.

Gross and *Szepesvary*, either alone or in combination, fail to teach or suggest the features recited in the presently claimed invention in independent claims 8, 19, and 25. Thus, any alleged combination of the prior art of reference cannot render obvious the claimed features generating a magnified display of a

first document in memory at a client and mapping the selected portion of the magnified display to the selected portion of the first document such that receiving a request for a first action in the second display would permit performing the action with respect to the first document because the cited references fail to teach or suggest these features.

Furthermore, neither *Gross* or *Szepesvary* teach, suggest, or given any incentive to analyze a document object model for a first document and identify a portion of the document object model that corresponds to the selected portion of the first document, wherein a magnified display of the selected portion of the first document is generated at the client based on the corresponding portion of the document object model for the first document in any portion of the reference.

The mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir 1989); *see also In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992); *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). The Examiner may not merely state that the modification or combination would have been obvious to one of ordinary skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification. As discussed above, the prior art fails to offer any suggestion or incentive for the proposed combination and modification of the references.

Furthermore, *Gross* actually teaches away from the presently claimed invention since *Gross* directs one to compress or decrease the size of portions of a document rather than magnify a portion of a document. Therefore, one of ordinary skill in the art would not be motivated to make the changes proposed by the Examiner.

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986). The present invention recognizes the problem encountered by users that are visually impaired and/or have difficulty with fine motor movements locating and selecting links on a web page. *Gross* does not recognize this problem. Instead, *Gross* is directed towards problems associated with displaying long or large documents in a window at the same time. See *Gross* at column 3, lines 5-18, shown above. *Gross* overcomes this problem by decreasing the size or compressing the display so that the entire document will fit in the window. As a result, information farthest from the localized view will appear smallest to the user. See *Gross* at column 10, lines 10-12, shown above. Thus, when *Gross* is examined as a whole, *Gross* teaches one of ordinary skill in the art to make a display smaller or more difficult for a user to see and read. In fact, as shown in Figure 7 and 8 above, the compressed portion of the display is not legible to a user. Thus, one of ordinary skill

would not be motivated make the Examiner's proposed modifications to reach the presently claimed invention when *Gross* is considered as a whole.

The presently claimed invention may only be reached through an improper use of the disclosed invention as a template to piece together and modify the prior art. The Examiner may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of Applicants' disclosure. *Id.* Therefore, absent some teaching, suggestion, or incentive in the prior art, the cited references cannot be properly combined to form the claimed invention. As a result, absent any teaching, suggestion or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of Applicants' disclosure as a model for the needed changes. Thus, the presently claimed invention in claims 8, 19, and 25 are not obvious over *Gross* in view of *Szepesvary*. In addition, dependent claims 9, 11, 22, and 26 depend from claims 8, 19, and 25. Therefore, claims 9, 11, 22, and 26 are not obvious over the cited prior art references at least by virtue of their dependency. Therefore, the rejection of claims 5-7 and 16-18 under 35 U.S.C. § 103 has been overcome.

VI. Conclusion

It is respectfully urged that the subject application is patentable over the cited prior art references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

/Mari Ann Stewart/

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